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PATENT TRADEMARK OFFICE

Docket No.: 00632000D916-USO

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Hsien-Jue Chu

Serial No.: 09/007,385

Art Unit: 1647

Confirmation No.: 4879

Filed: January 15, 1998

Examiner: Sharon L. Turner

For: **Streptococcus Equi Compositions and Methods of Use**

**REQUEST TO WITHDRAW HOLDING OF NOTICE OF ABANDONMENT  
PURSUANT TO 37 C.F.R. § 1.181**

Mail Stop Petition  
Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants in the above-identified patent application have received a Notice of Abandonment dated August 11, 2003 (copy enclosed at Tab A), advising that the application is abandoned due to Applicants' failure to timely file an appeal brief. Applicants herewith demonstrate that the application is not abandoned.

This Request to Withdraw Holding of Notice of Abandonment Pursuant to 37 C.F.R. § 1.181 is accompanied by a Change of Correspondence Address request, the August 11, 2003 Notice of Abandonment (Tab A), a copy of the non-final Office Action dated February 27, 2003 (Tab B), a copy of the Response to the February 27, 2003 Non-Final Office Action filed on August 27, 2003 (enclosed at Tab C), and documentation indicating that this Response was timely filed (enclosed at Tab D).

For the reasons set forth below, Applicants believe that this Notice is in error and should be withdrawn.

In the alternative, abandonment of the application was unavoidable under 37 C.F.R. § 1.137(a). If deemed necessary, the Commissioner is authorized to charge the fee under Rule 1.17(l) for the Petition to Revive to Deposit Account No. 04-0100.

It is believed that the evidence submitted herewith is an adequate showing that the Notice of Abandonment should be withdrawn or that abandonment of the application was unavoidable. However, if the Commissioner does not agree, in the alternative, abandonment was unintentional. The abandonment of the application and the entire delay from the due date of the reply until the filing of this petition pursuant to 37 C.F.R. § 1.137(b) was UNINTENTIONAL. If deemed necessary, the Commissioner is authorized to charge the fee under Rule 1.17(m) for the Petition to Revive to Deposit Account No. 04-0100.

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### **FACTS**

Upon receiving a copy of the August 11, 2003 Notice of Abandonment, Applicant's representative Paul F. Fehlner (Registration No. 35,135) called the examiner in charge of this application, Sharon Turner.

During a series of telephone calls between Dr. Fehlner and Examiner Turner on September 8 and 9, 2003, it was determined by Examiner Turner that although the last action mailed by the PTO was a Non-Final Office Action dated February 27, 2003 (Tab B), PALM incorrectly indicated that the last action mailed was an Advisory Action. Accordingly, the PTO failed to close the Appeal Brief deadline started by filing a Notice of Appeal on November 12, 2002. The date for filing any brief, with all available extensions of time, would have been June 12, 2003.

Prior to the August 11, 2003 Notice of Abandonment, the last action to be mailed by the PTO for the instant application was the February 27, 2003 Non-Final Office Action (Tab B) and Applicants timely filed a response to this Non-Final Office Action. A copy of this response is enclosed at Tab C.

The papers of Tab C demonstrate that US Postal Service Express Mail Certificate 306630285US contained the Response to Office Action with Exhibit 1, a Petition for Extension of Time, and a check for \$930.00 for payment of this extension of time. The paper shown in Tab D demonstrates that the papers

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accompanying Express Mail Certificate 306630285US were mailed on August 27, 2003 and that receipt of these papers was signed for by J. Steckel at the Patent Office, Alexandria VA 22313 on August 29, 2003. Thus, the documents submitted in Tabs C and D demonstrate that a response to the February 27, 2003 Office Action was timely filed and received by the PTO.

Applicants respectfully request entry of this Response and Amendment and consideration of the application on its merits.

**Change of Address**

Darby & Darby did not receive the above-mentioned Notice of Abandonment from the USPTO; it was incorrectly addressed to Wyeth, Five Giralda Farms, Madison, NJ 07940-0874. Applicants have requested previously and again request herein that U.S.S.N. 08/994,689 be associated with customer number 32801 and that the USPTO address all correspondence with respect to U.S. S.N. 08/994,689 to:

DARBY & DARBY P.C.  
Post Office Box 5257  
New York, NY 10150-5257  
212-527-7700

A Change of Correspondence Address request, USPTO form SB/122, accompanies the present request.

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## **CONCLUSION**

Darby & Darby filed a timely response to the February 27, 2003 Non-Final Office Action on August 27, 2003 with a Petition for three-months Extension of Time up to and including August 27, 2003. The USPTO incorrectly docketed the February 27, 2003 Non-Final Office Action as an Advisory Action and thus, incorrectly believed a Notice of Appeal and Appeal Brief were due prior to August 27, 2003 (i.e., by June 12, 2002). These USPTO-generated errors led to issuance of the erroneous August 11, 2003 Notice of Abandonment. Thus, it is respectfully requested that the Notice of Abandonment dated August 11, 2003 be withdrawn.

Alternatively, abandonment of the application was unavoidable under 37 C.F.R. § 1.137(a). It was unavoidable because the PTO incorrectly docketed the application for requirement of receipt of an appeal brief, rather than a response to non-final office action. As described above and documented herewithin, applicants timely filed a response to non-final office action on August 27, 2003. If deemed necessary, the Commissioner is authorized to charge the fee under Rule 1.17(l) for the Petition to Revive to Deposit Account No. 04-0100.

Although the facts indicate that the USPTO should withdraw holding of abandonment, or that abandonment was unavoidable, Applicants further submit that the abandonment was unintentional. The abandonment of the application and the entire delay from the due date of the reply until the filing of this petition pursuant to

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37 C.F.R. §1.137(b) was UNINTENTIONAL. A terminal disclaimer under Rule §1.137(c) is not necessary because this application was filed January 5, 1998. If deemed necessary, the Commissioner is authorized to charge the fee under Rule 1.17(m) for the Petition to Revive to Deposit Account No. 04-0100.

Applicants respectfully request entry of the Response and Amendment filed on August 27, 2003 (a copy of which is enclosed at Tab C) and consideration of the application on its merits.

Dated: September 16, 2003

Respectfully submitted,

*Heather Morehouse Ethiger 5/6/58*  
Heather Morehouse Ethiger for  
Paul F. Fehlner, Ph.D. *Paul Fehlner*  
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